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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,690

07/17/2003

Motoji Ohmori

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT

PAPER NUMBER

2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/620,690

Applicant(s)

OHMORI ET AL.

Examiner

Michael Pyzocha

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/12/04, 4/10/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-25 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the

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invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 13-15, 21-25 are rejected under 35

U.S.C. 102(e) as being anticipated by Russo et al. (US

20030115490).

As per claims 1, 13, 21, and 23-25 Russo et al. discloses a storage unit which stores therein storage authentication information that authenticates a user, and has an area that corresponds to the storage authentication information (see paragraph 40); a judgment unit operable to judge whether to perform authentication (see paragraph 46); a reception unit operable to receive reception authentication information that authenticates a user, if the judgment unit judges affirmative (see paragraph 52); an authentication unit that is tamper-resistant and is operable to judge whether the received reception authentication information matches the storage authentication information (see paragraphs 12, 46-52); and a process unit operable to permit use of the area if the reception authentication information is judged to match the storage authentication information (see paragraphs 46-52).

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As per claims 2, 3, 14, 15, and 22, Russo et al. discloses the storage unit further stores therein other storage authentication information different from the storage authentication information, and has another area that corresponds to the other storage authentication information, the authentication unit, instead of judging whether the received reception authentication information matches the storage authentication information, judges whether the received reception authentication information matches the storage authentication information, and judges whether the received reception authentication information matches the other storage authentication information, and the process unit further permits use of the other area, if the reception authentication information is judged to match the other storage authentication information with a detection unit operable to detect the mounting of the medium and performing the authentication after such detection (see paragraphs 46-52 and 54).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 4-8 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo et al. as applied to claims above, and in view of Shirai (US 6763249) and further in view of Bajikar (US 6577274).

As per claims 4-6 and 16-18, Russo et al. fails to disclose recording the history of mounting and using the time/date and position information in the history to determine when authentication is necessary.

However, Shirai teaches recording a history of the mounting of a medium (see column 5 lines 46-55).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to store the mounting history of the SIM card in the Russo et al. system.

Motivation to do so would have been to prevent the illicit copying of a user identification card (see Shirai column 1 lines 49-53).

The modified Russo et al. and Shirai system fails to disclose the use of historical time/date and position information to determine whether authentication is necessary.

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However, Bajikar teaches such authentication determination (see column 3 lines 40-67).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to determine whether authentication is needed based on time/date and position information in the modified Russo et al. and Shirai system.

Motivation to do so would have been to provide a security system that is capable of modifying the access policy (see Bajikar column 4 lines 8-10).

As per claims 7 and 8, the modified Russo et al., Shirai, and Bajikar system discloses the use of specific biometric information (see Russo et al. paragraphs 8-11 and 49-55).

8. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Russo et al., Shirai, and Bajikar system as applied to claim 4 above, and further in view of Bishop et al. (US 20020065106).

As per claims 9, 10, 19 and 20 the modified Russo et al., Shirai, and Bajikar system fails to disclose the medium storing a phone number which may be selected for use in communications.

However Bishop et al. teaches such information is stored and used on a medium (see paragraphs 7 and 53-56).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the phone

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number information in the medium of the modified Russo et al., Shirai, and Bajikar system.

Motivation to do so would have been to allow a user to choose different phone numbers to make and receive calls (see Bishop et al. paragraphs 53-56).

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russo et al. as applied to claim 1 above, and further in view of Gressel (US 6311272).

As per claim 11, Russo et al. fails to disclose writing the received authentication information to a storage area.

However, Gressel teaches such storing (see column 1 lines 34-48).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to store the most recent biometric sample in the Russo et al. system.

Motivation to do so would have been that biometric samples migrate and require the freshest sample (see Gressel column 1 lines 25-59).

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Russo et al. and Gressel system as applied to claim 11 above, and further in view of Bishop et al.

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As per claim 12 the modified Russo et al., and Gressel system fails to disclose the medium storing a phone number, which may be selected for use in communications.

However Bishop et al. teaches such information is stored and used on a medium (see paragraphs 7 and 53-56).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the phone number information in the medium of the modified Russo et al. and Gressel system.

Motivation to do so would have been to allow a user to choose different phone numbers to make and receive calls (see Bishop et al. paragraphs 53-56).

Conclusion

11: The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pecen and Croome teach methods of detecting a medium is mounted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJP


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER